

## REMARKS

The Office Action dated 4/3/06 rejected claims 1-6, 8-12, and 14-20 under 35 U.S.C. 102(a) as being anticipated by Meridian Project Systems, Inc. (www.mps.com), using the same art and rationale set forth in the final rejection of 03/03/2004. Further, claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Meridian Project Systems, Inc. (www.mps.com) in view of Smith ("Figuring profit must include equipment costs"). Claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over Meridian Project Systems, Inc. (www.mps.com) using the same art and rationale set forth in the final rejection of 03/03/2004.

10 The Section 102(a) Rejection

Applicants traverse the rejection since Meridian Project Systems, Inc. fails to show construction management system with a handheld computer adapted to collect construction data from the field, wherein the handheld computer collects information on equipment type, quantity, hours in use and stand-by hours; a planning system to track budgetary information that manages multi-year budgets; a design system to perform site engineering assessment; and a construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from the handheld computer, wherein the information is transmitted in real time to the construction system to provide up-to date-reporting, wherein new equipment added in the construction system is automatically displayed on the handheld computer, and wherein an electronic signature is captured and displayed in a construction system report.

Withdrawal of the Section 102 rejection is requested.

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The Section 103(a) Rejection

Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Meridian Project Systems, Inc. (www.mps.com) in view of Smith ("Figuring profit must include equipment costs"). The Office Action noted that:

5           As per claim 7, Meridian Project Systems, Inc. discloses a system wherein the handheld computer collects equipment information, including summary information by company (See page 1, sections 1-4, page 3, section 2, page 11, and page 15, section 5, wherein the handheld computer collects equipment type).

10           However, Meridian Project Systems, Inc., does not expressly disclose that this information includes type, quantity, hours in use and stand-by hours.

          Smith discloses that equipment information includes type, quantity, hours in use and stand-by hours (See page 1, section 1, page 2, sections 1-2, page 3, sections 1-2, wherein equipment information including individual pieces of equipment by type being tracked per job, including in use and standby hours).

15           Meridian Project Systems, Inc. discloses collecting and reporting information about equipment used in a construction project. Smith discloses field reporting per individual machine per job including usage and standby hours. It would have been obvious to one of ordinary skill in the art at the time of the invention to include type, quantity, hours in use and stand-by hours in the information collected and transmitted by Meridian Project Systems, Inc. in order to increase the accuracy and the detail of the information collected and stored in the system. See page 1, section 2, of Meridian Project Systems, Inc. that discusses the importance of accurate and detailed information. See also Smith, page 3, sections 2-3, which also discusses accurately collecting job cost data and accurately allocating equipment based on reported data.

Applicants respectfully traverse the Section 103 rejection over Meridian and Smith. Smith relates to an article on The Master Builder Software by Omware.

30           Turning to the claims in the instant case, the independent claims recite a handheld computer adapted to collect construction data from the field, wherein the handheld computer collects information on equipment type, quantity, hours in use and stand-by hours; a planning system to track budgetary information; a design system to perform site engineering assessment; and a construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from

the handheld computer, wherein the information is transmitted in real time to the construction system to provide up-to date-reporting, wherein new equipment added in the construction system is automatically displayed on the handheld computer, and wherein an electronic signature is captured and displayed in a construction system report.

- 5       The Office Action asserted that Meridian shows a "planning system to track budgetary information (See at least page 1, sections 1-2, page 2, section 1, page 3, section 3, page 13, sections 1-3, pages 14-16, page 17, sections 1-3, page 19, and page 28, sections 1-3, wherein planning system features are disclosed that track the budget information)." However, this part of Meridian is essentially an accounting system. The
- 10   Meridian system cannot track funding sources, the allocation of the funding sources, and scheduling information. Meridian also cannot maintain data relating to preliminary site feasibility studies such as estimates of the cost of the project. Hence, at least the planning system is missing in Meridian and this is one basis to traverse the rejection.

- 15       In the instant invention, the specification discloses an embodiment of the planning system as a budgetary system that tracks funding sources, the allocation of the funding sources, and scheduling information. As noted on pages 16-17 of the application, in one embodiment, "the planning system 102 includes a Fund/Source Module that maintains multi-year budget plans for the overall CIP process. This allows program managers to create a multi-year Capital Improvement Plans and track the funding sources by program,
- 20   fund, and by source. Each CIP plan is controlled separately to maintain a historical record of the previous year's CIP plan. This Planning System controls and manages the data associated with this process." Meridian does not manage the multi-year capital improvement budget process for program management that requires a system to adjust

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projects based on priorities, condition assessments, and maintenance considerations.

Since the planning system is not taught by Meridian, this is one basis for traversing the Section 102 rejection.

The claims also recite a design system. As disclosed in the specification, in one  
5 embodiment, the design system 104 allows the user to perform detailed site assessments. The user can check for a variety of concerns, for example environmental concerns. The design system 104 also allows the user to start a preliminary design that meets predefined requirements on a particular project. The design system 104 also performs contract  
10 management aspects of the design contract, including tracking whether a design engineering company or an architectural firm has delivered certain items. The design system 104 also performs contract management and archives any court document control such as correspondence between an owner and a design firm.

The Office Action asserted that Meridian shows a "design system to perform site engineering assessment (See at least page 1, sections 1-4, page 2, section 1, page 3,  
15 sections 1-5, page 13, sections 1 and 3, page 15, and page 28, sections 1-3, which includes a system for engineers and engineering site analysis)." Applicants have carefully reviewed the pages, and failed to find the design system. Although page 15 of Meridian mentions the word "Engineering", but the Meridian Engineering functionality is limited to document management for engineering diagrams and not a design system to  
20 perform site engineering assessment. To illustrate, page 15 is replete with logs, records of conversations, drawing history/list/packages, and submittal packages and transmittal cover sheet. However, there is no design functionality in Meridian.

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In the instant application, one embodiment of the design functionality is described as follows: "The design system 104 allows the user to perform detailed site assessments. The user can check for a variety of concerns, for example environmental concerns." Meridian is completely silent on the design system that can address environmental concerns in the claimed design system. Hence, at least the design system element is missing from Meridian. This is another independent basis for traversing the rejection.

The Office Action also asserted that Meridian shows a "construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from the handheld computer (See at least page 1, sections 1-2, page 2, section 1, page 3, sections 1-5, page 4, page 13, sections 1-3, pages 14-16, page 17, sections 1-3, page 19, and page 28, sections 1-3, which discloses a construction system to track progress and material consumption to generate reports using information from the handheld computer)."

As disclosed in the specification, one embodiment of the construction system 106 tracks the actual materials consumed and the progress of the project. For example, data relating to construction items previously bid upon can be reviewed in determining the quantity of material delivered and the payment to a particular contractor for its construction items. The system 106 can track on a daily basis the quantities of the materials being delivered to the job site, the progress of the work and the resulting pay estimate sheets. The construction system 106 also performs various contract management functions, including archiving all contract documents and correspondence associated with a particular construction management construction firm.

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The Office Action relied on Smith to show that the handheld computer collects equipment type, quantity, hours in use and stand-by hours. There is no showing that Smith suggests or teaches modifying Meridian to arrive at a construction management system with a handheld computer adapted to collect construction data from the field, wherein the handheld computer collects equipment type, quantity, hours in use and stand-by hours; a planning system to track budgetary information that manages multi-year budgets; a design system to perform site engineering assessment; and a construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from the handheld computer. There is no teaching that the handheld computer collects equipment type, quantity, hours in use and stand-by hours in Smith or Meridian. Further, Meridian does not show that the information is transmitted in real time to the construction system to provide up-to-date reporting, wherein new equipment added in the construction system is automatically displayed on the handheld computer, and wherein an electronic signature is captured and displayed in a construction system report.

Hence, Meridian and Smith cannot render obvious the independent claims as well as the claims that depend therefrom.

A review of the requirement for a *prima facie* case of obviousness is helpful. Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

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5 must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

10 The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex*  
15 *parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

20 Appellant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in  
25 Smith, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Meridian so as to produce the claimed invention of claims 7 and 13. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding

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or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation  
5 in the Meridian reference, or knowledge of those skilled in the art, for arriving at a construction management system with a handheld computer adapted to collect construction data from the field. Hence, *prima facie* obviousness of claims has not been established. As such, it is respectfully requested that the § 103(a) rejection of independent claims be withdrawn and the claims be allowed.

10 Claim 13 was rejected under Section 103a as unpatentable over Meridian. The Office noted that:

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meridian Project Systems, Inc. (www.mps.com).

15 Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meridian Project Systems, Inc. (www.mps.com) using the same art and rationale set forth in the final rejection of 03/03/2004.

Applicants respectfully traverse the rejection since claim 13 depends from allowable claim 1. Moreover, since Meridian and Smith fail to show at least the design  
20 system to perform site engineering assessment, Meridian and Smith cannot render claim 13 obvious. Withdrawal of the §103 rejection is respectfully requested.

Authorization to Charge Deposit Account 501861 is granted.

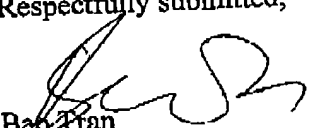
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of  
25 Allowance at an early date is respectfully requested.

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If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-528-7490.

Respectfully submitted,

  
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